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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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09/324,168

06/02/1999

HIROYUKI NITTA

500.33793R00

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7590

03/04/2003

ANTONELLI TERRY STOUT AND KRAUS
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ARLINGTON, VA 22209

EXAMINER

WU, XIAO MIN

ART UNIT

PAPER NUMBER

2674

DATE MAILED: 03/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/324,168

Applicant(s)

NITTA ET AL.

Examiner

XIAO M. WU

Art Unit

2674

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 6/2/99 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☒ Certified copies of the priority documents have been received in Application No. 08/464,133.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

Reissue Applications

1. The original patent filed 1/11/2002 has been received
2. Upon further considering the application, the previous Final office action is withdrawn and a new office action is provided as follow.
3. Claims 1-28 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See ***Hester Industries, Inc. v. Stein, Inc.***, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); ***In re Clement***, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); ***Ball Corp. v. United States***, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.
4. Specific attention is directed to the new independent claims 17, 21 and 25. As set forth in applicant's reissue declaration, applicant states that "at least one error of the patentees claiming more or less than the patentees had the right to claim in the original patent upon which reissue is based is the recitation in claim 1 of the original patent of "simultaneously generates two different display voltages from the selected display voltage level"". During the prosecution of the parent application, applicant added the above limitations into the claim 1 of the parent application to

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distinguish the prior art reference to Yamazaki. And at paper No. 12 of the parent file, applicant specifically argued that Yamazaki's level shifter circuit 216 does not simultaneously generate two different display voltages as does output means 129, 131 in Figs. 9 and 11 of the present application.

5. As set forth in *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); arguments made to overcome prior art, even when made in absence of any claim amendment, can evidence admission sufficient to give finding of surrender within meaning of recapture rule, which prohibits grant of reissue claims that are broader than original claims in manner directly pertinent to subject matter surrendered during prosecution.

6. Applicant's independents 17, 21 and 25 are broader than the original patent claim 1 in exactly the area argued for patentability in the parent prosecution.

7. Although the recapture rule may be avoided in some circumstances, such as where claims that are broader in certain respects were materially narrowed in other respects, independent claims 17, 21 and 25 do not appear to be materially narrowed to avoid recapture.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Xiao Wu whose telephone number is (703) 305-4721.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Hjerpe, can be reached on (703) 305-4709.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

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(703) 872-9314

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377

xw

February 26, 2003


XIAO WU
PRIMARY EXAMINER
ART UNIT 2674